

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. HALL, EDWARD T. SHEERAN, JR. and
MICHAEL S. SULLIVAN

Appeal No. 96-2608
Application 08/068,498¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge and
FRANKFORT and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4, 5, 8 and 11, and from the examiner's refusal to allow claims 2 and 7 as amended subsequent to the

¹Application for patent filed May 27, 1993.

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final rejection in a paper filed April 12, 1995 (Paper No. 10). Claims 3, 6, 9, 12 and 15 through 18 stand allowed. Claims 10 and 13, the only other claims pending in the application, have been objected to, but are indicated to be allowable if rewritten in independent form. Claim 14 has been canceled.

Appellants' invention relates to an adapter for use in a fixed angle centrifuge rotor for holding a centrifuge tube containing a substance to be subjected to centrifugation. Claim 1 is representative of the subject matter on appeal and a copy of that claim, as it appears in the Appendix to appellants' brief, is attached to this decision.

The sole prior art reference of record relied upon by the examiner is:

Stallmann	DE 3,343,846	Jun. 13, 1985
(German Offenlegungsschrift) ²		

² Our understanding of this German language document is based upon a translation prepared by the U.S. Patent and Trademark Office. A copy of that translation accompanies this decision.

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Claims 1, 4, 5, 8 and 11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stallmann.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Stallmann.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 22, mailed November 27, 1995) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 21, filed October 19, 1995) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given

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careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions

articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of appealed claims 1, 4, 5, 8 and 11 under 35 U.S.C. § 112, second paragraph. After reviewing appellants' specification and claims, and appellants' arguments on page 4 of their brief, it is our opinion that the scope and content of the subject matter embraced by appellants' independent claims 1 and 4 on appeal are clear and definite, and fulfill the requirement of 35 U.S.C. § 112, second paragraph, that they provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and

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evaluate the possibility of infringement and dominance. See, In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). Like appellants, we have no doubt that the term "itself" in claims 1 and 4 on appeal refers back to the inboard portion of the adapter, and therefore that independent claims 1 and 4, and dependent claims 5, 8 and 11, do particularly point out and distinctly claim that which appellants regard as their invention

and are definite within the meaning of the Statute. Accordingly, we will not sustain the examiner's rejection of appellants' claims 1, 4, 5, 8 and 11 under 35 U.S.C. § 112, second paragraph.

We next look to the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by Stallmann. Like the examiner, we view the removable and replaceable plastic insert (4) of Stallmann's centrifuge rotor as being an "adapter" for use in the centrifuge rotor. As seen in Figures 1-3 of Stallmann, the rotor itself is formed of the hub (1), lower part (2) and upper part (3) which are configured and arranged to

receive the removable and replaceable insert (4) which carries the sample containers (6) in recesses defined therein. The insert/adaptor (4), while being spun, will have a "portion" that lies radially inboard and a portion that lies radially outboard with respect to the axis of rotation of the rotor. We view the "portion" that lies radially inboard as being the entire inner surface of the insert/adaptor (4) and we note that this surface has openings therein defined by the spaces between the ribs(5) of Stallmann's insert. In view of this understanding of the rotor and insert/adaptor of Stallmann, we find

appellants' arguments as set forth on page 5 of their brief to be unpersuasive and we will therefore sustain the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 102(b).

As for the examiner's rejection of claim 7 under 35 U.S.C. § 103 based on Stallmann, we will also sustain this rejection. In light of our discussions above regarding the insert/adaptor (4) of Stallmann, we find appellants'

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assertions of hindsight reconstruction to be unpersuasive. Moreover, we note that appellants have not in any way specifically addressed the examiner's stated position concerning the obviousness of making the insert (4) of Stallmann from a light transmissive plastic material so as to allow visual observation of the sample containers (6) while in the adapter (4).

To summarize our decision, we note that the examiner's rejection of claims 1, 4, 5, 8 and 11 under 35 U.S.C. § 112, second paragraph, has not been sustained; but that the examiner's rejection of appealed claims 1 and 2 under 35 U.S.C. § 102(b) relying on Stallmann has been sustained, as has the examiner's rejection of claim 7 under 35 U.S.C. § 103.

The decision of the examiner is, accordingly, affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

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§ 1.136(a).

AFFIRMED-IN-PART

	HARRISON E. McCANDLISH)	
	Senior Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	CHARLES E. FRANKFORT)	APPEALS
AND)	
	Administrative Patent Judge)	
INTERFERENCES)	
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)	
	JOHN P. McQUADE)	
	Administrative Patent Judge)	

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